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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/530,776  | 12/19/2005  | Meir Shinitzky       | 74127JPW/JW         | 9387             |
| 23432 7590 11/12/2009<br>COOPER & DUNHAM, LLP<br>30 Rockefeller Plaza<br>20th Floor<br>NEW YORK, NY 10112 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| SHTERENGARTS, SAMANTHA L  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1626  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 11/12/2009  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/530,776

**Applicant(s)**

SHINITZKY ET AL.

**Examiner**

Samantha L. Shterengarts

**Art Unit**

1626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-72 and 135-212 is/are pending in the application.
- 4a) Of the above claim(s) 49-72, 135-164, 169-180, and 186-212 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 165-168 and 183-185 is/are rejected.
- 7) ☒ Claim(s) 181-182 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/22/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Amendments filed July 22, 2009 are acknowledged.
2. All rejections not explicitly maintained herein are withdrawn.

***Election/Restrictions***

3. Applicant's election with traverse of Group VII, Claims 165-185 in the supplemental reply filed on January 16, 2009 is acknowledged. The traversal is on the ground(s) that method of use claims of Group I should be examined along with the elected product claims. This is not found persuasive for the following reasons.

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since, under 37 CFR 1.475(a)

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Groups I-IX lack unity of invention since under 37 CFR 1.475: the technical feature corresponding to the claims is the O-CO moiety. This is the core technical feature because it is the only non-variable core that is common to all compounds of formula (I). This core technical feature is not a special technical feature because it fails to define a contribution over the prior art, as can be seen in the U.S.C. 103 rejection below.

Therefore, claims 49-72 and 135-212 are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a special technical feature as the technical feature present fails to define a contribution over the prior art. The core technical feature that is being claimed is taught by the prior art. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Furthermore, in regards to Groups I-IX, even if unity of invention under 37 CFR 1.475(a) is not considered lacking, which it is as evidenced above, unity is lacking under 37 CFR 1.475(b). Under 37 CFR 1.475(b): A national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of said product, and a use of said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of said product, and an apparatus or means specifically designed for carrying out the said process.

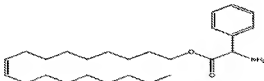
And according to 37 CFR 1.475(c): if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph 37 CFR 1.475(b), unity of invention might not be present.

Therefore, since the claims are drawn to compounds and compositions, which do not make a contribution over the prior art, as well as *various* methods of using the compounds, as in claims 49-72, 135-164, and 186-212, and according to 37 CFR 1.475(e): the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claims.

Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical feature, the claims lack unity of invention.

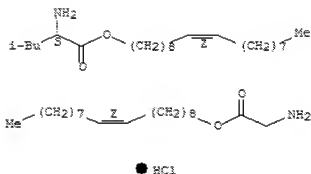
The requirement is still deemed proper and is therefore made FINAL.

4. As per MPEP 803.02, the Examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species of the following compound:



makes a contribution over the prior art of record. Therefore, according to MPEP 803.02: should the elected species appear allowable, the search of the Markush-type claim will be extended. If

the search is extended and a non-elected species is not found allowable, the Markush-type claim shall be rejected and claims to the nonelected invention held withdrawn from further consideration. The search of the Markush-type claim has been extended to include the products of the following formulae:



As a non-elected species has been found not allowable, the Markush-type claims have been rejected and claims to the nonelected invention held withdrawn from further consideration.

Claims 165-168 and 181-185, have been examined to the extent to which they are readable on the elected embodiment and the above identified nonelected species. Since art was found on a nonelected species, subject matter not embraced by the elected embodiment or the above identified nonelected species is therefore withdrawn from further consideration. It has been determined that the entire scope claimed is not patentable.

#### ***Status of the Claims***

5. Currently, Claims 49-72 and 135-212 are pending in the instant application. Claims 49-72, 135-164, 169-180, and 186-212 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention and species. Claims 165-168 and 181-

185 read on an elected invention and species and are therefore under consideration in the instant application insofar as they read on the elected species above.

***Claim Rejections - 35 USC § 102***

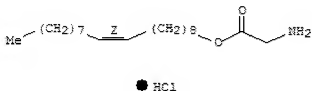
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 165-168 and 183-185 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kida et al. [Kida, Takao. Mechanism of Inhibitory Action of Lauryl DL-Valinate.HCL on Plant Growth. *Agric. Biol. Chem.* 41 (6), 931-937 (1977).]

Kida et al. teaches the following compound and its hydrochloride salt, which anticipates the instant claims:



7. Claims 165-168 and 183-185 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mori et al. (U.S. Patent no. 4,826,818).

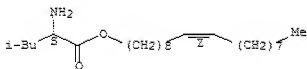
Mori et al. teaches compounds of the formula:



where  $R_1$  is hydrogen, an alkyl group, an  $\omega$ -hydroxyalkyl group, an aralkyl group or an  $\omega$ -hydroxyaralkyl group and  $R_2$  is a saturated hydrocarbon or unsaturated hydrocarbon radical having 2 to 22 carbon atoms.

, more specifically, Mori. et al. teaches compounds

and compositions of the following formula, which anticipates the instant claims:



### *Claim Objections*

8. Claims 181-182 are objected to for depending on a rejected base claim.

### *Conclusion*

9. No claims are allowed.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shtrengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samantha L. Shtrengarts/  
Examiner, Art Unit 1626

/Kamal A Saeed/  
Primary Examiner, Art Unit 1626